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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,204	05/03/1999	ADRIAN GROPPER	915780/002	9355

7590 10/03/2002

PATENT ADMINISTRATOR
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EXAMINER

HUYNH, CONG LAC T

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/304,204

Applicant(s)

GROPPER ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,11,12,15-26 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 3-6,8-10,13-14 and 27-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: the application filed on 5/3/99, and the IDS filed on 1/30/02.
2. Claims 1-37 are pending in the case. Claims 1, 12, 19, 26, 35 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 12, the term "sufficient" in claim 12 (line 6) is a relative term which renders the claim indefinite. The term "sufficient" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not clear how many information should be contained to be sufficient to link the predetermined text portion and link information as claimed.

Claims 13-18 are also rejected as being dependent on claim 12.

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Regarding claim 17, which is dependent on claim 11, the number 11 is a typographical error within "the method of claim 11, further comprising..." since the claim should be dependent on claim 12.

Claim 18 is rejected as being dependent on claim 17.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96).

Regarding independent claim 1, Kraft discloses a document comprising:

- a text section (figure 7, the text section above the broken line)
- an endnote section, the endnote section being independent of the text section and including information for linking portion of text contained in the text section to predetermined link information (figure 7, the section below the broken line, this section includes the hyperlink for linking portion of text contained in the text section to predetermined link information)

Though Kraft does not explicitly mention a report, the hypertext document in Kraft inherently includes a report since a report is merely a form of document.

Regarding independent claim 12, Kraft discloses:

- creating the text for a document (figure 8, #138-#140, the hypertext document selection by the graphical user interface inherently shows that the text document is created; col 7, line 64 to col 8, lines 1-4)
- retrieving link information to be displayed along with the text in association with a predetermined portion of the text (figure 6, #124; figure 7, #130, #134; figure 8, #142)
- creating an independent endnote containing information sufficient to link said predetermined text portion and link information (figure 8, #144, generate footnote, #146, associate footnote with hyperlink address which is included in the text portion)
- attaching the endnote to the document after the text (figure 7, the endnote is attached to the document after the text)

As in claim 1 above, though Kraft does not explicitly mention a report, the hypertext document in Kraft inherently includes a report since a report is merely a form of document.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96).

Regarding claims 2 and 16, which are dependent on claims 1 and 12 respectively, Kraft does not disclose that said link information includes an image. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include an image into the link information since it was well known in the art that a hyperlink can be in text or image form.

Regarding independent claim 19, Kraft discloses:

- opening and displaying the text at a terminal (figure 8, #138, #140)
- activating the link (figure 6, #124, col 7, lines 40-49, IBM link is activated by user clicking)

- identifying the appropriate endnote corresponding to the activated link (figure 7, the endnote include the activated link)

Kraft does not disclose retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information.

Instead Kraft discloses that from the graphical interface includes, a user can select a command from a pull down menu for viewing or printing a selected data (col 6, lines 24-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information since a user can select the link information in accordance with the information included in the endnote for displaying instead of selecting other data for displaying from the menu.

10. Claims 7, 11, 15, 17-18, 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft as applied to claims 1,12, 19 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 7, which is dependent on claim 1, Kraft does not disclose that said endnote section includes a plurality of endnotes.

Nielsen discloses the endnote section includes a plurality of endnotes (figures 9B-C; col 12, lines 16-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote section creating with more data included in the endnote section.

Regarding claim 11, which is dependent on claim 1, Kraft does not disclose an end marker being a signature.

Nielsen discloses a note "An internal Reference" at the end of the text section (figures 9B-C). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include a signature as an end marker of the text section since a signature is merely a short text as a short note.

Regarding claim 15, which is dependent on claim 12, Kraft does not disclose that the endnote includes text modification *instructions for modifying the display* of the predetermined portion of the text to indicate that characters contained in the predetermined portions are linked.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in a predetermined portion of the text to indicate that the character contained in the predetermined portions are linked (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text modification instructions for modifying the display of the predetermined portion of the

text to indicate that characters contained in the predetermined portions are linked since it is possible to replace another instruction in the endnote.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote creation where the content of the endnote may include both the link information or any instruction related to the text document.

Regarding claims 17 and 18, which are dependent on claims 11 and 17 respectively, Kraft does not disclose providing an end of text marker after the text and attaching the endnote to the report after the end of the text marker wherein the end of text marker is a signature.

As mentioned in claim 11 above, Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include a signature as an end marker of the text section since a signature is merely a short text as a note.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to easily differentiate each separate section in a document by a signature as end marker to mark at the end of each section.

Regarding claim 20, which is dependent on claim 19, Kraft does not disclose that the endnote includes text modification *instructions for modifying the display* of the text to be linked and modifying the display of the text in accordance with the instructions.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in the display of the text to indicate the portion of the text to be link (figures 9B-C, the endnote includes the instruction "See note #2").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text modification instructions for modifying the display of the text to indicate the portion of the text to be linked since one can replace one instruction by another instruction.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote content to include a modifying instruction for modifying the selected text in accordance with the instructions in addition to displaying and printing instructions.

Regarding claim 21, which is dependent on claim 19, Kraft and Nielsen do not disclose retrieving the link information from a repository.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft and Nielsen to include retrieving the link information from a repository since it was well known in the art that all the information data is stored in a database, which is a repository, for retrieving data later on.

Regarding claim 22, which is dependent on claim 19, Kraft discloses that the link information is a web site (figure 7, #130).

Regarding claim 23, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion line by line into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion line by line...until the signature is read" and "operating on the endnote...."since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure. Since each line includes a number of characters, reading characters in the lines is considered as reading line by line.

Regarding claim 24, which is dependent on claim 23, Kraft does not disclose operating upon each line of text by inserting said line of text into a Java Swing document, and modifying the text in accordance with the instructions stored in the endnote to indicate where links exist.

Instead Kraft discloses the commands in the menu for displaying and printing documents (col 6, lines 24-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the Kraft menu to incorporate the inserting and modifying commands for modifying documents in text section or in the endnote section to enhance menu commands applied on the documents.

Regarding claim 25, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion *character by character* into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion character by character...until the signature is read" and "operating on the endnote...."since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camphell et al. (US Pat No. 6,208,974, 3/27/01, filed 12/30/97).

Regarding independent claim 26, Camphell does not disclose:

- creating an endnote having a workflow state portion and encoding the protocol in said workflow state portion
- the endnote including a work state indicator, and storing a workflow state in the workflow state indicator
- performing a step in the protocol and changing the workflow state value stored in said workflow state indicator to indicate the performed step has been completed

Instead Camphell discloses:

- a workflow state portion and the protocol of said workflow state portion (figure 10, #1004, #1006; col 17, line 51 to col 18, lines 1-5)

- a work state indicator and storing a workflow state in the workflow state indicator (figure 10, #1008; col 17, line 65 to col 18, lines 1-5, "the series of check buttons that enables the user to record the status of the treatment protocol" shows that the status of the treatment protocol, which is considered as a workflow state, is recorded in check buttons as state indicators)
- performing steps in the protocol and showing that the performed step has been completed (figure 10, #1006, **Otoscopic Exam – complete**)

Though Camphell does not disclose creating an endnote including the workflow state portion, Camphell discloses the workflow state portion and the workflow state indicator in a document.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Camphell to incorporate an endnote of a document to include the workflow state portion and the workflow state indicator since the endnote is also a section of a document.

12. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96) in view of Camphell et al. (US Pat No. 6,208,974 B1, 3/27/01, filed 12/30/97).

Regarding independent 35, Kraft discloses:

- a character information portion containing information for identifying the address within text of the report to be linked with ancillary information (figure 7, #130, #134)

Kraft does not disclose a view state information directed to the view state of the ancillary information and a workflow state information portion for containing workflow state information.

Camphell discloses a view state information directed to the view state of the ancillary information and a workflow state information portion for containing workflow state information (figure 10, #1006, the information of steps, considered as states in a workflow, in a treatment protocol, #1008, the information of the status of treatment protocol, considered as the view state information).

It is noted that Camphell does not disclose that the view state information and the workflow state information are included in the format of an endnote.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Camphell to include said information in the endnote of a document since the endnote is a section of a document.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Camphell into Kraft to obtain a sufficient report with an endnote including specific information related to the data reported in the text section.

Regarding claim 36, which is dependent on claim 35, Kraft does not disclose the work state information includes a work state indicator for storing a workflow state therein.

Campbell discloses the work state information includes a work state indicator for storing a workflow state (figure 10, #1008; col 17, line 65 to col 18, lines 1-5, "the series of check buttons that enables the user to record the status of the treatment protocol" shows that the status of the treatment protocol, which is considered as a workflow state, is recorded in check buttons as state indicators).

As mentioned in claim 35 that Campbell does not disclose that the view state information and the workflow state information are included in the format of an endnote. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Campbell to include said information in the endnote of a document since the endnote is a section of a document.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Campbell into Kraft to obtain a sufficient report with an endnote including specific information related to the data reported in the text section.

Regarding claim 37, which is dependent on claim 35, Kraft does not disclose that the view state information portion includes at least a link information address corresponding to the address from which the ancillary information can be retrieved.

Instead Kraft discloses in the endnote a link information address corresponding to the address from which the ancillary information can be retrieved (figure 7, #130, #134).

Campbell discloses the view state information in a document (figure 10, #1008).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Campbell into Kraft to include the view state information of Campbell in the endnote of Kraft since the endnote is a section of a document. The combination of Campbell and Kraft would provide a good report with extra information in the endnote related to the data reported in the text section.

Allowable Subject Matter

13. Claims 3,13, 27-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Claims 4-6, 8-10 are also objected as being dependent on claim 3.
15. Claim 14 is also objected as being dependent on claim 13.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cooper et al. (US Pat No. 4,996,662, 2/26/91).

Borgendale et al. (US Pat No. 5,276,793, 1/4/94).

Templeman (US Pat No. 5,845,303, 12/1/98, filed 10/2/96).

Ishikawa et al. (US Pat No. 5,854,888, 12/29/98, filed 3/1/93).

Young (US Pat No. 6,006,236, 12/21/99, filed 12/22/97).

Flores et al. (US Pat No. 6,073,109, 6/6/00, filed 12/22/96).

Tarumi (US Pat No. 6,115,640, 9/5/00, filed 1/16/98).

Evans (US Pat No. 6,029,167, 2/22/00, filed 7/25/97).

Rosenthal et al. (US Pat No. 6,311,192 B1, 10/30/01, filed 12/17/98).

Agarwal et al. (US Pat No. 6,286,129 B1, 9/4/01, filed 12/2/97).

Blandford (US Pat No. 6,442,691 B1, 8/27/02, filed 2/27/95).

Neuwirth et al., The Notes Program : A Hypertext Application for Writing from Source Texts, ACM, 11/1987, pages 121-141.

Carr et al., Link Servies or Link Agents ?, ACM, 1998, pages 113-122.

Tygar, Atomicity in Electronic Commerce, ACM, 5/1998, pages 32-43.

Quint et al., Combining Hypertext and Structured Documents in Grif, ACM, 1992, pages 23-32.

Berrut et al., Indexing Medical Reports in a Multimedia Environment: the RIME experimental approach, ACM 1989, pages 187-197.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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746-7239 for regular communications and 707-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
9/26/02


STEPHEN S. HONG
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.